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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,520	01/25/2001	Nancy Karen Zangle	40186.0001US01	5868

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EXAMINER

NGUYEN, SON T

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 12/17/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/770,520

Applicant(s)

ZANGLE ET AL.

Examiner

Son T. Nguyen

Art Unit

3643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 13-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, drawn to a cat toy, classified in class 119, subclass 707.
 - II. Claims 13-15, drawn to a method of fabricating a cat toy, classified in class 119, subclass 174.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the cat toy as claimed can be made by another and materially different process. The cat toy can be made without the step of attaching a cloth layer to the interior passage of the toy. In addition, the cat toy can be made by using polyethylene material thus would eliminate the step of providing a spring-steel coiled wire for structural support.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Paul Prendergast on 11/20/01 a provisional election was made without traverse to prosecute the invention of group I, claims 1-12. Affirmation of this election must be made by applicant in replying to this

Office action. Claims 13-15 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

6. Claims 8,9 are objected to because of the following informalities: in claim 8, the word "material" should be changed to ---film---to be consistent. In claim 9, the word "form" should be changed to ---from---. Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claim 1** is rejected under 35 U.S.C. 102(b) as being anticipated by Curley et al. (US 5,564,454).

For claim 1, Curley et al. disclose a cat toy comprising a flexible elongated tube 1 having a first end (end where ref. 3 is located), a second end (end where ref. 4 is located) and a middle portion (the middle of the tube around ref. 2), the middle portion having an exterior surface and an interior surface. The tube of Curley et al. is made

from a crinkly plastic film (col. 5, lines 48-55) molded to a tubular shaped coiled wire scaffolding, wherein movement of a cat or other pet within the elongated tube causes the emission of noise from the crinkly plastic film.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 2-4,6,8,10,11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Curley et al. (US 5,564,454).

For claims 2-4, Curley et al. further disclose the tube can be made out of multiple layers 20-22 (col. 3, lines 40-45) made out of a material that is washable (col. 5, lines 38-41). However, Curley et al. are silent that the material is a fabric material such as nylon, cotton, rayon, etc. Since they did teach a washable material which is well known that a fabric material is washable, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a fabric material such as the above listed as the preferred washable material for the tube of Curley et al. since it is well known that fabric is washable, which is what Curley et al. want their tube to be made out of.

For claim 6, Curley et al. further disclose the tube having a substantially circular cross section but they are silent about the tube having a diameter from 10 to 20 inches. It would have been obvious to one having ordinary skill in the art at the time the

invention was made to have the diameter of the tube of Curley et al. from 10 to 20 inches, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges involves only routine skill in the art.

For claim 8, Curley et al. disclose the crinkly plastic film is preferred to be Markosite styrene (col. 5, line 54) but they are silent about the film being polyethylene. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use polyethylene in place of the Markosite styrene of Curley et al. , since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious choice.

For claims 10 & 11, Curley et al. are silent about the tube's length being from 24 to 72 inches or 36 to 60 inches. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the length of the tube of Curley et al. from 24 to 72 inches or 36 to 60 inches, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges involves only routine skill in the art.

11. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Curley et al. (US 5,564,454) in view of Johnson (US 5,921,204). Curley et al. are silent about the tube having at least one air hole. Johnson teaches an expandable tube 8 in which he employs air holes 25a along the tube or at certain section of the tube so as to prevent condensation in the tube and allows entry of fresh air into the tube (col. 3, lines 24-29).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ at least one air hole as taught by Johnson in the tube of Curley et al. in order to prevent condensation in the tube and to allow entry of fresh air into the tube.

12. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Curley et al. (US 5,564,454) in view of Westphal (US 5,620,396). Curley et al. are silent about having a cover at either the first or second ends of the tube. Westphal teaches a toy tunnel in which he employs a cover (can be seen at refs. A,D,B rolled up) to cover the ends of an elongated tunnel. The cover of Westphal can be rolled up and attached to Velcro if one wishes to not have the cover covering the tunnel. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a cover as taught by Westphal in the tube of Curley et al. in order to cover either the entrance or exit of the tube. Curley et al. as modified by Westphal's are silent about the cover being removable because the cover at the ends are a part of an integral large sheet of cover. However, it is notoriously well know that covers at entrances or exits can be made to be removable in a shelter or tunnel structure. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the cover of Curly et al. as modified by Westphal be removable since it is notoriously well know that cover at entrance/exit can be made to be removable.

13. **Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over Curley et al. (US 5,564,454) in view of Zoroufy (US 5,351,646). Curley et al. are silent about catnip being suspended from an interior surface of the middle portion. Zoroufy teaches

an animal hair collecting device in which Zoroufy employs catnip in the cat toy 90 suspended from the interior of the device to further entice the animal in the device (col. 13, lines 40-45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ catnip as taught by Zoroufy suspended from the interior surface of the tube of Curley et al. in order to further entice an animal in the toy. Curley et al. as modified by Zoroufy are silent about the location of the catnip, i.e. being placed in the middle portion. It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the catnip of Curley et al. as modified by Zoroufy anywhere along the interior surface of the tube depending on the user's preference.

14. **Claim 12** is rejected under 35 U.S.C. 103(a) as being unpatentable over Curley et al. (US 5,564,454) in view of Zheng (US 5,618,246). Curley et al. are silent about the coiled wire scaffolding 7-9 being a spring-steel coiled wire. Zheng teaches a play tunnel in which Zheng employs spring steel coiled wire 22 to support the tunnel and to allow the tunnel to be versatile (col. 4, lines 39-41). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a spring-steel coiled wire as taught by Zheng in place of the elastic member 7-9 of Curley et al. in order to support the tube and to allow the tube to be more versatile.

Oath/Declaration

15. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

Art Unit: 3643

The oath or declaration is defective because: It does not state or disclose a claim for domestic priority under 35 U.S.C. 119(e) to a provisional application.

16. The following prior arts are made of record to provide the best available relevant examples of a cat toy: US5711744 teaches a helical tube recreational component.

US5690584 teaches multi-directional movable recreational equipment device.

US3895796 teaches a toy and sports device. US3848615 teaches a collapsible and foldable shelter. US4979242 teaches a collapsible room shelter.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is (703) 305-0765. The examiner can normally be reached on Monday - Friday from 8:30 a.m. to 5:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon, can be reached at (703) 308-2574. The fax number of the Art Unit is (703)-306-4195. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-4177.

Son T. Nguyen, *STN*
Patent Examiner, GAU 3643
December 12, 2001



MICHAEL J. CARONE
SUPERVISORY PATENT EXAMINER